

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DANIEL A. JAPUNTICH,  
VAUGHN B. GRANNIS, HAROLD J. SEPPALA  
and ANTHONY B. FERGUSON

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Application 09/680,465

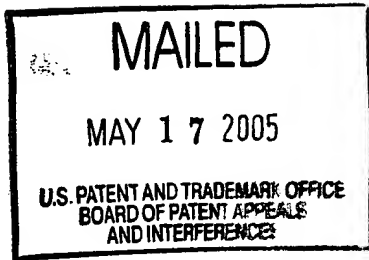
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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on March 3, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

Appellants filed a Notice of Appeal on August 6, 2003 "from the last decision of the Examiner dated May 7, 2003 rejecting claims 33, 35-57, 60-63, and 66-83." The "Status Of Claims" section located on page 1 of the Appeal Brief filed November 10, 2003 agrees with the above statement. Page 2



of the Examiner's Answer mailed December 16, 2003, notes that "[t]he statement of the status of the claims contained in the brief is correct." However, the "Grounds of Rejection" section appearing on pages 4-13 of the Answer states:

Claims 33, 35-46, 48-57, 66-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al ('516) in view of McKim ('618) [page 5]; and

Claims 60-63, 83 [are] rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of McKim as applied to claim[s] 33, 35-46, 48-57, 66-82 above, and further in view of Warbasse ('706) and Braun ('362) [page 12].

It should be noted that the Final Rejection mailed May 7, 2003 and the Examiner's Answer mailed December 16, 2003, do not appear to discuss the rejection of claim 47 although the handwritten addition of claim 47 appeared in the Office communication mailed July 17, 2002. Confusion exists regarding the status of claim 47. Appropriate correction is required.

In addition, on April 26, 2002, four affidavits were filed (Bowers, Fabin, Betts and Castiglione). While the examiner acknowledges the Bowers, Fabin and Betts affidavits on pages 15 and 16 of the Final Rejection mailed May 7, 2003 and on pages 14 and 15 of the Examiner's Answer mailed December 16, 2003, it is

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not clear whether the Castiglione affidavit was considered.  
Appropriate correction is required.

Lastly, an examination of the file reveals that Information Disclosure Statements (IDSs) were filed on April 7, 2005 and May 3, 2005. It is not apparent from the record whether the examiner considered the statements submitted or notified appellants of why their submissions did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Accordingly, it is

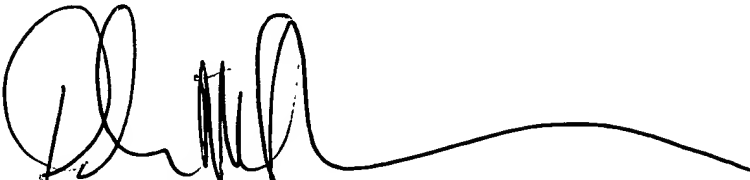
ORDERED that the application is returned to the  
Examiner:

1. for a determination regarding the status of claim 47;
2. for consideration of the Castiglione affidavit filed April 26, 2002;
3. for consideration of the IDSs filed April 7, 2005 and May 3, 2005;
4. for proper notification to appellants regarding the above matters;

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5. for such further action as may be appropriate.

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AND INTERFERENCES

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